increased activity and a decreased propensity for despair, and a method of identifying an agent that modulates the expression and function of a phenotype associated with a disruption in a stefin homolog gene);

Invention II, Claim 16 (drawn to an agent that modulates expression of a stefin homolog gene disruption-associated phenotype of a transgenic mouse); and

Invention III, Claim 27 (drawn to phenotypic data associated with the transgenic mouse). As such, the Office Action requests restriction of the claims to one of the three cited groups. Thus, the Applicant provisionally elects, with traverse, Invention Group I (claims 1-15 and 17-26) and respectfully requests reconsideration and withdrawal of the requirement in view of the remarks set forth below.

REMARKS

The MPEP has defined the criteria for a request for a proper claim restriction. According to the MPEP:

> "[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions:
> (a)The inventions must be independent or distinct as claimed; and
> (b)There **must be a serious burden on the examiner** if restriction is required."

MPEP §803.

This section makes clear that "if the search and examination of an entire application can be made **without serious burden**, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**." *Id.* As such, if a restriction requirement fails to meet the "serious burden" requirement, then it is unnecessary to determine whether the alleged claim groups are independent or distinct.

The Office Action implies that a serious burden is placed on the Examiner because it asserts that Invention Groups I and II, and I and III have separate classifications. The Office Action provides that: (a) Invention Group I belongs to Class 800, subclass 3, and (b) Invention Group II belongs to Class 530, subclass 300+, and (c) Invention Group III belongs to Class 369. Although the Office Action categorizes Claims 1-27 into three Invention Groups, all claims are drawn to related subject matter. Specifically, Claims 16 (Group II) and 27 (Group III) depend from Group I claims. For example, Claim 11 (Invention Group I) is drawn to a method of

identifying an agent that modulates the expression of a stefin homolog and Claim 16 (Invention Group II) is drawn to the agent identified by the method of Claim 11. Another example of the relatedness among the Groups is Claim 17 (Invention Group I), which is drawn to a transgenic mouse comprising a homozygous disruption in a gene and Claim 27 (Invention Group III), which is drawn to phenotypic data of the transgenic mouse of Claim 17. Thus, the two claims which are asserted to belong to separate subject matters are, in fact, closely associated with the claims identified as Group I. As such, while the search classifications asserted by the Examiner are different from each other, the search is not a "serious burden" because the invention groups are so related as to lend themselves to a search that would not be overly burdensome. Thus, the Applicant urges that all claims (Claims 1-27) of the present application be examined on the merits. Accordingly, the Examiner is respectfully requested to withdraw the restriction requirement.

Although Applicant has provisionally elected Group I for purposes of advancing prosecution of the present application, the Applicant contends, for the foregoing reasons, that the restriction requirement is improper under MPEP §803. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the requirement.

Respectfully submitted,
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